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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,622	03/01/2002	Edward A. Grabover	012A.0001.U1 (US)	7933

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

8

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,622

Applicant(s)

GRABOVER ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-7 and 17-31 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 8-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato (U.S. Pat. 3,557,780) for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 9.

3. Claims 1 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ouchi (U.S. Pat. 6,547,723) as set forth in numbered paragraph 5 of the previous Office Action, paper number 9.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (Jap. Pat. 9-24019) in view of Sato (U.S. Pat. 3,557,780) for the reasons set forth in numbered paragraph 9 of the previous Office Action, paper number 9.

Allowable Subject Matter

6. Claims 3-7 and 17-31 allowed.

7. Claims 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed January 9, 2004 have been fully considered but they are not persuasive.

Regarding claims 8-11, 17-23 and new claim 31, Applicant argues that the specific angles and radii claimed are not "design choice" as purported by the Examiner since a special structure is required to accomplish these angles that is not explicitly shown or suggested in the prior art. This argument is persuasive. Therefore, rejections on any of these claims have been withdrawn.

Claim 1 now recites that "the first and second active deflection sections are adapted to deflect such that a distal end of the ureteropyeloscope is sized and shaped to be placed in a calyx of a lower pole of a kidney without passively deflecting the front end of the shaft against tissue of the kidney reach the calyx of the lower pole". Applicant argues that such intended use language is a structural and functional limitation. The Examiner respectfully disagrees. Although Applicant cites MPEP 2173.05(g) regarding functional language in the claims, only certain portions of such citation, taken out of context, are pointed out.

The context of MPEP 2173.05(g), as understood by the Examiner, refers to how the invention functions within itself and not how it is intended to be used. For example, a proper

Art Unit: 3739

functional limitation (when defining structure) would still make sense when the invention was used in a different procedure, or for that matter, sitting on a table in front of the Examiner.

An example of a functional limitation that is given weight when defining a claimed apparatus can be seen in Applicant's claims. For instance, "adapted to deflect in a first direction about 155 degrees to 190 degrees with a radius of curvature of about 9-12 mm" is a function of the shaft that defines a certain structure by what it does instead of what it is. Specific shaft structure is not provided, just the function of this specific shaft structure. This function is not based on any intended conditional use within a particular body organ, during a particular time of day, or during particular weather conditions. It concisely defines the functioning of the structure in and of itself.

Even if such language defined present structural attributes of the claimed assembly by how they work, it appears to be defining structural attributes already present in the claim (e.g., two independently deflectable active deflection sections). Applicant does not particularly point out what structural attributes are intended to be defined by the alleged "functional" language. The mere fact that particular attributes can not be clearly determined indicates that such language is not sufficient "functional" language.

Regarding the Ouchi reference, Applicant implies that the filing date is no good (although this is not specifically stated). Surely Applicant realizes that the claimed subject matter is not included in the parent application. If Applicant feels otherwise, a statement on the record should be made and a clear argument against the use of the Ouchi reference should follow.

Conclusion

Art Unit: 3739

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

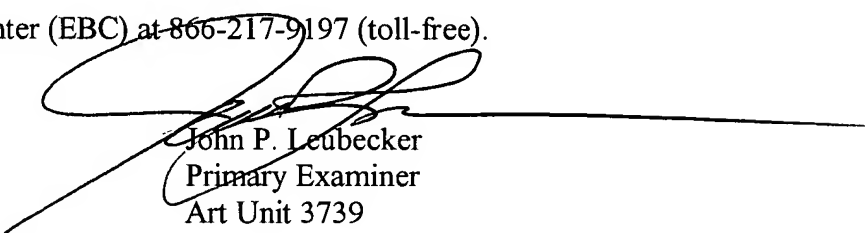
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl